

Application No. 10/001,573
Paper Dated January 6, 2005
Attorney Docket No. 128346.31801

INTERVIEW SUMMARY AND REMARKS IN SUPPORT OF PETITION
FOR RECONSIDERATION OF FINALITY OF FINAL REJECTION

The relevant prosecution history of this application is:

- The Applicants filed the original application on November 2, 2001.
- The Examiner issued a First Office Action in the original application on February 18, 2004.
- The Applicants filed a Response to the First Office Action on May 14, 2004.
- The Examiner issued a Final Office Action in the original application on July 9, 2004.
- The Applicants filed a Response to Final Office Action on September 9, 2004, in which the independent claims were amended to incorporate the limitations of certain dependent claims.
- On September 20, 2004, the Examiner and Applicants' attorney had a telephone conference in which the Examiner stated that an English Translation was required in order to consider the after-final amendments. A copy of the Interview Summary was included in the Advisory Action mailed September 24, 2004 (described in next bullet).
- On September 24, 2004, the Examiner issued an Advisory Action stating that the after-final amendments would not be entered because they raised new issues that require further consideration and/or search.
- On October 11, 2004, in response to the September 20, 2004 telephone conference and the September 24, 2004 advisory action, the Applicants filed a Request for Continued Examination ("RCE").
- On October 14, 2004, after the Applicants filed the RCE, the Examiner issued a Second Advisory Action stating that the after-final amendments would be entered.
- On November 3, 2004, in response to the RCE, the Examiner issued a First Office Action that was characterized as a Final Office Action.

MPEP § 706.07 states that "it would not be proper to make final a first Office action in a continuing or substitute application where that application contains material which

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was presented in the earlier application after final rejection or closing of prosecution but was denied entry because (A) new issues were raised that required further consideration and/or search". As shown in the bullet list above, the history of the present application precisely matches the circumstances for which MPEP § 706.07 states that final action is improper. Here, the Examiner stated that after-final amendments would not be entered because the Examiner believed that an English translation of French Patent 2686101 was necessary to consider the amendments. Accordingly, Applicants promptly filed the RCE in order to obtain full consideration of the amendments in view of the English translation. The issuance of the second Advisory Action after the Applicants filed the RCE does not change the requirements of MPEP § 706.07.

On January 3, 2004, the undersigned attorney and the Examiner had a telephone conversation in which the Examiner stated that he believed withdrawal of the finality of the Office Action mailed November 3, 2004 was appropriate in this case.

Based on the facts and reasons set forth above, Applicants hereby request that the Office reconsider the finality of the Office Action mailed November 3, 2004 and recharacterize that Office Action as non-final.

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REMARKS IN RESPONSE TO OFFICE ACTION

MAILED NOVEMBER 3, 2004

In the Office Action mailed November 3, 2004, the Examiner states that French Patent 2686101 discloses an oxygen getter in an amount sufficient to improve the toughness of a CBN product. Applicants respectfully disagree. Rather, as shown in the English translation of the French Patent (attached hereto as Attachment A), French Patent 2686101 teaches the inclusion of aluminum, boron, silicon, zirconium or titanium as a catalyst additive to increase the *yield and size* of the resulting crystals. See Attachment A, p. 2. As noted in previous Office Action responses, the French Patent does not describe the use of aluminum, boron, silicon, zirconium or titanium *as an oxygen getter to improve the toughness of the crystals*.

In the Office Action, the Examiner states that French Patent 2686101 discloses the inclusion of the additive in the amounts claimed in the present application. However, the additives described in the French Patent are limited to elemental Al, Si, B, Zr and Ti (see page 3 of the French Patent) in amounts ranging from: (i) a low end of 0.25 weight-% of the blend (in the case wherein the ratio of hBN-to-catalysts is 20 to 1, and the ratio of the additive to alkaline or alkaline-earth nitrides is 0.05 to 1), to (ii) a high end of 25 weight-% of the blend (in the case wherein the ratio of hBN-to-catalysts is 1:1, and the ratio of the additive to alkaline or alkaline-earth nitrides is 1:1). Accordingly, the high amounts indicate that the French Patent teaches the use of the additive as a catalyst rather than as an oxygen getter that would yield a product having an improved toughness, such as a product having an oxygen content of less than 300 ppm.

Applicants have amended claim 1 of the present application to relate to an elemental oxygen getter. Even if the elemental additive described in the French Patent could be

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considered to be an oxygen getter, neither the French Patent nor any other prior art discloses the use of an elemental additive in amounts less than or equal to about 0.24 wt % of the blend. Applicants have found such amounts to improve the toughness of the resulting product and have amended claim 1 to clarify this range.

In addition, neither the French Patent nor any other prior art discloses a method of improving the toughness of a CBN product comprising forming a blend of an oxygen getter and a CBN product-forming feedstock, and subjecting the blend to an HP/HT process in the presence of a catalyst, wherein the oxygen getter comprises one or more nitrides of Al, Si, and Ti, and/or carbides of Al, Si, and Ti. Applicants have amended independent claim 23 and presented independent claim 36, each of which includes these features.

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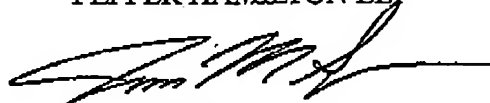
CONCLUSION

In light of the above amendments and remarks, Applicants respectfully submit that all pending claims as currently presented are in condition for allowance. Applicants respectfully request the Examiner to pass the case to issue at the earliest convenience.

In the event that the Examiner does not believe that these remarks will place the claims in condition for allowance, the undersigned hereby requests a telephone interview with the Examiner before the next Office Action.

The Commissioner is hereby authorized to charge any additional fees which may be required for this submission, or credit any overpayment, to Deposit Account No. 50-0436.

Respectfully submitted,
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Date: January 6, 2005

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